

### REMARKS

This Amendment responds to the Office Action dated January 4, 2006 in which the Examiner rejected claims 1, 3-8, 13-17, 19, 21-24 and 30-34 under 35 U.S.C. §102(b) and rejected claims 9-12, 18, 25-29 and 35 under 35 U.S.C. §103.

As indicated above, claims 1, 4, 5, 19, 22 and 23 have been amended for stylistic reasons. The amendments are unrelated to a statutory requirement for patentability and do not narrow the literal scope of the claims.

Claims 1, 3-8, 13-17, 19, 21-24 and 30-34 were rejected under 35 U.S.C. §102(b) as being anticipated by *Maxwell* (U.S. Patent No. 5,805,810).

Applicant respectfully traverses the Examiner's rejection of the claims under 35 U.S.C. §102(b). The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, applicant respectfully requests the Examiner withdraws the rejection to the claims and allows the claims to issue.

*Maxwell* is directed to a method of generating mail from email messages and includes receiving an email message from a sender, locating an identifier for a sender and a recipient in databases and generating the mail from the email message. Thus, *Maxwell* is directed to converting a single email message into a single mail message to be mailed to a recipient. However, as claimed in claims 1, 4, 5, 19, 22 and 23, the method is for printing and making ready for mailing a plurality of documents intended for a plurality of addressees. Thus, *Maxwell* teaches away from the claimed invention and is directed to converting an email message into a postal mail for a single recipient.

Additionally, *Maxwell* merely discloses a sender database 1300 containing identifiers for senders 1310 and information on whether each sender has postage (credit) 1320 (column 13, lines 19-22), and a recipient database including a) identifiers 1410 and street addresses 1420 for senders and b) nickname identifiers 1430, post office addresses and full names for recipients (column 13, lines 38-43). Nothing in *Maxwell* shows, teaches or suggests selecting a single priorly stored file including a) instructions concerning a design of printed content to be printed on the documents and b) pre-mailing instructions concerning making the printed documents ready for mailing, as claimed in claims 1, 4, 5, 19, 22 and 23. Rather, *Maxwell* only discloses two different databases: one having a sender's name and credit information and the other containing names and addresses of senders and recipients.

*Maxwell* merely discloses that the recipient database contains recipient nickname identifiers 1430. Nothing in *Maxwell* shows, teaches or suggests selecting a symbol which represents a file of presentation instructions including a) design instructions concerning a design of printed content to be printed on documents and b) pre-mailing instructions concerning making the printed documents ready for mailing as claimed in claims 4 and 22. Rather, *Maxwell* only discloses recipient nickname identifiers stored in a recipient database.

Finally, *Maxwell* merely discloses at column 9, lines 19-30, determining if a sender has sufficient credit for postage in order to process and generate the mail object. Nothing in *Maxwell* shows, teaches or suggests a) editing a file of instructions concerning a design of printed content to be printed on documents and instructions concerning making the printed documents ready for mailing or b) the

editing is executable exclusively under a different authorization than user authorization as claimed in claims 5 and 23. Rather, *Maxwell* merely discloses determining whether there is sufficient credit in a sender's account in order to mail the message.

Since nothing in *Maxwell* shows, teaches or suggests the primary features as claimed in claims 1, 4, 5, 19, 22 and 23, applicant respectfully requests the Examiner withdraws the rejection to claims 1, 4, 5, 19, 22 and 23 under 35 U.S.C. §102(b).

Claims 3, 6-8, 13-17, 21, 24 and 30-34 recite additional features. Applicant respectfully submits that claims 3, 6-8, 13-17, 21, 24 and 30-34 would not have been anticipated by *Maxwell* within the meaning of 35 U.S.C. §102(b) at least for the reasons as set forth above. Therefore, applicant respectfully requests the Examiner withdraws the rejection to claims 3, 6-8, 13-17, 21, 24 and 30-34 under 35 U.S.C. §102(b).

Claims 12, 18 and 35 were rejected under 35 U.S.C. §103 as being unpatentable over *Maxwell*. Claims 9-11 and 27-29 were rejected under 35 U.S.C. §103 as being unpatentable over *Maxwell* and further in view of *McCauley et al* (U.S. Patent No. 6,434,578). Claims 25-26 were rejected under 35 U.S.C. §103 as being unpatentable over *Maxwell* and further in view of *Daniels, Jr. et al* (U.S. Patent No. 6,343,327).

Applicant respectfully traverses the Examiner's rejection of the claims under 35 U.S.C. §103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, applicant respectfully requests the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in *Maxwell* shows, teaches or suggests the primary features as claimed in claims 1, 4-5, 19, 22 and 23, applicant respectfully submits that the combination of the primary reference with the secondary references will not overcome the deficiencies of the primary reference. Therefore, applicant respectfully requests the Examiner withdraws the rejection to claims 9-12, 18, 25-29 and 35 under 35 U.S.C. §103.

The prior art of record, which is not relied upon, is acknowledged. The references taken singularly or in combination do not anticipate or make obvious the claimed invention.

Thus it now appears that the application is in condition for reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, applicant respectfully petitions for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

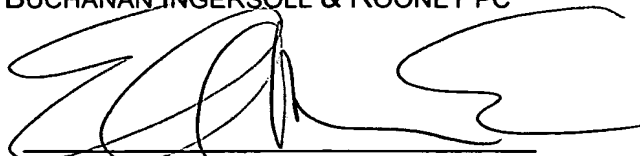
In the event that any additional fees are due with this paper, please charge  
our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: July 5, 2006

By:

A handwritten signature in black ink, appearing to read 'EMAS', written over a horizontal line.

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